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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,927	01/14/2004	Robert A. Dolan	57111-5124	6337

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EXAMINER

BRITTAIN, JAMES R

ART UNIT PAPER NUMBER

3677

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,927

Applicant(s)

DOLAN ET AL.

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 16-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01142004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Applicant's election of a hook comprising the species of figures 1-7 in the response received September 23, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction, requirement the election has been treated as an election without traverse (MPEP §818.03(a)).

Claims 16-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made without traverse in the paper received September 23, 2005.

Drawing Objections

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "second straight portion extends toward the main shaft in a non-parallel relationship" (claim 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 9 indicates that the "second

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straight portion extends toward the main shaft in a non-parallel relationship”. However, the drawings and specification are silent on how this is configured. It appears that the non-parallel relationship is described in the specification only for the section 12a shown for example in figure 4.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is indefinite because applicant elected the species of figures 1-7 and the specification only indicates that the second straight portion is parallel to the main shaft for the elected species, so it is unclear how this claim can read on the elected species thereby rendering the scope of the claim indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-15 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Sorenson (US 2169298).

Sorenson (figure) teaches a safety hook structure comprising a main shaft 10, a portion 11 inherently capable of receiving a chain at a first end of the main shaft, a first bend 12 disposed

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at a second end of the main shaft substantially vertically in-line with the chain receiving portion; and a second bend 17 depending from the first bend that bends in substantially the opposite direction of the first bend. Applicant is reminded that the transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.* 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). As to claims 14 and 15, the safety of hook of Sorenson possesses all of the structure of the hook within these claims and is fully capable of being used “for coupling a trailer to a towing vehicle using a chain” if so desired. There is nothing precluding the fastener of Sorenson from such a use.

Claims 1-8 and 10-15 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Taylor (US 2016756).

Taylor (figures 1, 2) teaches a safety hook structure comprising a main shaft 12, a portion 13 for receiving a chain at a first end of the main shaft, a first bend 10 disposed at a second end of the main shaft substantially vertically in-line with the chain receiving portion by being located on the same side of the main shaft; and a second bend 11 depending from the first bend that bends in substantially the opposite direction of the first bend. Applicant is reminded that the transitional term “comprising”, which is synonymous with “including,” “containing,” or

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“characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.* 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). As to claims 14 and 15, the safety of hook of Taylor possesses all of the structure of the hook within these claims and is fully capable of being used “for coupling a trailer to a towing vehicle using a chain” if so desired. There is nothing precluding the fastener of Taylor from such a use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor (US 2016756) in view of Jacobson et al. (US 732081).

Taylor (figures 1, 2) teaches a safety hook structure comprising a main shaft 12, a portion 13 for receiving a chain at a first end of the main shaft, a first bend 10 disposed at a second end of the main shaft substantially vertically in-line with the chain receiving portion by being located on the same side of the main shaft; and a second bend 11 depending from the first bend that bends in substantially the opposite direction of the first bend. The difference is that the second

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straight portion does not extend toward the main shaft in a non-parallel relationship. However, Jacobson et al. (figure 3) shows an species where the second bend 4 has a second straight portion that extends in a direction toward the main shaft 1 so as to provide better engagement. Since improved engagement is beneficial, it would have been obvious to modify the safety hook of Taylor so that the second straight portion extends toward the main shaft in a non-parallel relationship in view of Jacobson et al. (figure 3) showing a species where the second straight portion extends in a direction toward the main shaft 1 so as to provide for better engagement.

Claims 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Simpson et al. (CA 2337983) in view of either Taylor (US 2016756) or Sorenson (US 2169298).

Simpson et al. (figures 3-5, 8 and the last drawing) teach a security hook for coupling a trailer to a towing vehicle using a chain 102, the chain being engaged with the trailer, the towing vehicle having a platform with a hole 112 therein, the security hook comprising: a main shaft 14 having a first end and a second end; a chain receiving portion 12 extending from the first end of the main shaft and dimensioned to receive the chain; and a U-shaped hook 16, 16a extending from the second end of the main shaft and the U-shaped hook dimensioned to engage the hole in the towing vehicle platform. Simpson et al. also indicate "Preferably, the first bend portion 16 bends to the opposite side of the main shaft portion 14 as the chain receiving member 12. However, this is not a limitation on the present invention" (page 4, line 29 - page 5, line 1). So, Simpson et al. disclose that while preferable the first bend portion 16 opposite the chain receiving portion, it can bend in another direction and so suggests that it is worthwhile to do so. It would have been obvious to bend the first bend portion to the same side of the main shaft as the chain receiving portion in view of either Taylor (figures 1, 2) teaching a safety hook structure

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comprising a main shaft 12, a portion 13 for receiving a chain at a first end of the main shaft, a first bend 10 disposed at a second end of the main shaft substantially vertically in-line with the chain receiving portion by being located on the same side of the main shaft; and a second bend 11 depending from the first bend that bends in substantially the opposite direction of the first bend so as to better align the main shaft between the chain receiving portion and first bend or Sorenson (figure) teaching a safety hook structure comprising a main shaft 10, a portion 11 inherently capable of receiving a chain at a first end of the main shaft, a first bend 12 disposed at a second end of the main shaft substantially vertically in-line with the chain receiving portion; and a second bend 17 depending from the first bend that bends in substantially the opposite direction of the first bend so as to better align the main shaft between the chain receiving portion and first bend.

Conclusion

The patents of Robinson (US 1473876, figures 2, 3), Bayer (US 5104082, figures 2, 3) and Attwood et al. (US 545043, figures 1-3) teach pertinent fastener structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (571) 272-7065.

The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB